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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,852	01/15/2002	Daniel A. Hilbrich	29929/10000	5104
4743	7590	03/30/2006	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			ALEXANDER, REGINALD	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/047,852

Applicant(s)

HILBRICH, DANIEL A.

Examiner

Reginald L. Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-8, 10-12, 14-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 14-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Reissue Applications*

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The most recent declaration filed on January 27, 2003 is improper in that the declaration does not meet the requirements of 37 CFR 1.63(a)(4) and 1.63(b)(2).

Applicant uses language such as:

*"I believe that I am the original and first inventor of the subject matter which is described and claimed in US Patent No. 6,016,740 (hereinafter the '740 patent) issued on January 25, 200, and for which invention I now solicit and broadening reissue patent."*

and...

*"I hereby state that I have reviewed and understand the contents of the "740 patent specification, including the claims, as amended by the "Preliminary Amendment."*

This language is unacceptable because it is not referring to the instant reissue application (specification and claims) but rather to the patent specification and claims.

Claims 1-8, 10-12, 14-21 and 23-28 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7, 8, 10, 12, 14, 16-18, 21, 23, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al.

There is disclosed in Smith a filtering device 10, comprising: a spout 24 to deliver heated water under elevated pressure (col. 3, lines 52-56) to coffee beans; a receptacle (col. 2, lines 22-27) to receive brewed filtered coffee; means 37, 38 defining a flow path between the beans to the receptacle; a metallic (permanent) filter 44 in the path of heated coffee; and a filter layer 42, the filter optionally being of filter paper (col. 4, lines 51 and 52) in the path of the heated coffee. The filtering device is disclosed for use with various types of coffee makers, i.e. espresso coffee makers.

It should be noted that while Smith discloses element 44 as a “foraminous support”, such functions as a filtering element. Thus, contrary to the view point presented in the Affidavit submitted July 9, 1999, there are two different filtering elements disclosed in Smith. The permanent or metallic filter 44 provides support for an additional filtering element 42 which, as discussed above, can be a layer of filter paper.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 6, 19, 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of Krebs.

Krebs discloses that it is known in the art to form a filter 10 of multiple layers 12, 14. It would have been obvious to one skilled in the art to modify the construction of the Smith filter 42 with that taught by Krebs and form it of multiple layers, in order to improve the efficiency of the filter. The formation of multiple layers together by crimping is an obvious matter of design choice, since the overall effectiveness of the filter is not contingent upon the way the layers are formed together.

Claims 5, 11, 15, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al.

Smith, as discussed above, discloses all of the claimed subject matter except the desired lipid removal value. Applicant has failed to disclose any particular chemical makeup of the filter paper which would allow it to have the absorbency characteristics described in the claims. It is known in the art that the presence of fats (lipids) from the coffee grounds can make for an undesirable taste in the final coffee product. Thus, the use of filter paper for the removal of fats to improve the taste of coffee. An increase in the amount of fats removed from the coffee grounds, and therefore a better taste, can be clearly linked to the thickness or number of filter paper layers used in the filter. In regards to the claims, it would have been obvious to one skilled in the art to achieve, with the Smith reference, the desired fats removal from the coffee grounds, for the

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reasons set forth in the comments above and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reginald L. Alexander whose telephone number is 571-272-1395. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rla  
February 23, 2006

  
Reginald L. Alexander  
Primary Examiner  
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